REMARKS

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

By virtue of the claim amendments presented, supra, claims 5-9,13-16, 23-28 and 35-42 are canceled without prejudice. Claims 1, 17-21, 29-31, 33 and 43-46 are being amended. Claims 2-4, 10-12, 22, 32 and 34 remain in the application without being amended. No new claim is added.

1. Drawings

Applicants note with appreciation that the Examiner has accepted all formal drawings filed on October 26, 2001.

2. Allowed subject matter

Applicant notes with appreciation that the Examiner has indicated that claims 15-19, 28, 29, 31, 32 and 41-45 would be allowable over the prior art of record if the double patenting rejections set forth in the outstanding Office action were overcome.

3. Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 20, 26 and 46 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding claims 20 and 46, the Examiner asserted that "the claims recite 'wherein the bonding step is performed at a temperature below the temperature at which any polymer present degrades' in lines 1-3 of each claim. These claims are indefinite because they do not clearly define whether or not polymer is present." Whereas Applicants do not agree with this rejection, Applicants have amended claims 20 and 46 to specify that a polymer is present. Thus this issue is not longer present.

Applicants have canceled claim 26 without prejudice.

4. Double patenting rejection

The Examiner has rejected claims 21-32 of the present application provisionally under 35 U.S.C. § 101 as claiming the same invention as that of claims 21-32 of copending application No. 10/255,777.

Applicants submit that by virtue of the amendments made herein to claims 21-32, and possible amendments to claims 21-32 of copending application 10/255,777, this issue is or will be resolved.

The Examiner further rejected claims 1-20 and 33-46 provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 and 33-46 of the copending Application No. 10/255,777. The Examiner asserted that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other."

Since the claims in both applications are not in a finalized form, and both may be amended, it is premature for Applicants to address this issue at this time. Applicants invite the Examiner to issue one of these two applications first, when either of them is in a condition for allowance, and this issue will then be addressed by Applicants in the remaining application.

5. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-3, 10, 12-14, 20, 33, 39 and 40 under 35 U.S.C. § 102(b) as being anticipated by Meissner (United States Patent No. 5,846,638).

The Examiner has rejected claims 33-38 and 46 under 35 U.S.C. § 102(e) as being anticipated by Ebbers (United States Patent Application Publication No. 2002/0108556 A1).

In page 14 of the detailed action of the Office action, the Examiner has indicated that the originally claim 15 would be allowable if the double patenting rejection were overcome. The Examiner stated that claims 15-19 "would be allowable over the prior art of record because none of the prior art references of record either alone or in combination disclose or render obvious a method as defined in claim 15, including all the steps of contacting the bonding surface of the optical fiber and the surface of the article with an acid in combination with the limitations of the base and intervening claims." The Examiner made similar statements as to the patentability of originally filed claims 28 and 41, both including the step of contacting the bonding surface with an acid in combination with the limitations of the base and intervening claims.

Claims 1, 21 and 33, as amended herein, contain a step of contacting the surfaces to be bonded with an acid, and a step of treating the bonding surfaces with a solution having a pH greater than 8 such that surface termination groups selected from –OH, ≡Si-OH, =Si-

$(OH)_2$, $-Si(OH)_3$ and $-O-Si-(OH)_3$ and combinations thereof are formed on the surfaces. Neither Meissner nor Ebbers discloses all these limitations.

Thus, claims 1, 21 and 33 are not anticipated by either Meissner or Ebbers. Other claims, dependent from one of them, are not anticipated, accordingly.

6. Rejections under 35 U.S.C. § 103

The Examiner has rejected originally filed claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Frey et al. (United States Patent No. 5,631,986) in view of Ebbers (United States Patent Application Publication No. 2002/0108556 A1).

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Meissner in view of Frey et al.

The Examiner has rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Meissner in view of Duvall et al. (United States Patent No. 5,579,421).

The Examiner has rejected claims 21-27 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Basavanhally (United States Patent No. 5,346,583) in view of Ebbers.

None of the above rejections were rendered against originally filed claims 15, 28 and 41.

Indeed, as discussed supra, the Examiner has indicated that claims 15, 28 and 41 would be allowable if the double patenting rejection were overcome.

Claims 1, 21 and 33, as amended herein, all contain an additional step of contacting the surfaces to be bonded with an acid, and a step of treating the bonding surfaces with a solution having a pH greater than 8 such that surface termination groups selected from –OH, $\equiv Si-OH$, $=Si-(OH)_2$, $-Si(OH)_3$ and $-O-Si-(OH)_3$ and combinations thereof are formed on the surfaces.

For substantially the same reasons the Examiner outlined for the patentability of originally filed claims 15, 28 and 41, claims 1, 21 and 33 are not unpatentable under 35 U.S.C. § 103(a).

7. Conclusion

Based upon the above amendments, remarks, Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record considered by the Examiner. Applicants are submitting herewith or will submit a supplementary information disclosure statement containing additional references, if any. If a

supplementary information disclosure statement is filed, Applicants respectfully request the Examiner to reconsider the claims as amended herein in light of the new references to be submitted. In case the Examiner does not deem the claims as amended herein are unpatentable over the applicable new references, Applicant respectfully requests a prompt Notice of Allowance for the subject application.

Applicants believe that no extension of time is necessary to make this Amendment timely. Should Applicants be in error, Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Amendment timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

The undersigned attorney is granted limited recognition by the Office of Discipline and Enrollment of the USPTO to practice before the USPTO in capacity as an employee of Corning Incorporated. A copy of the document granting such limited recognition either has been previously submitted or is submitted herewith for the record.

Please direct any questions or comments to the undersigned at (607) 248-1253.

Respectfully submitted,

CORNING INCORPORATED

Date: December 16, 2003

Siwen Chen
Limited Recognition
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Mail Stop SP-TI-03-1
Corning, NY 14831

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop: Non-Fee Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

December 16, 2003

Colleen E. Doherty